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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,992	03/28/2001	Bradford H. Needham	P 0275014 P10427	9762

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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,992

Applicant(s)

NEEDHAM ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on May 9, 2003. In the amendment,

5 claims 1, 7, 19, 21, and 24 were amended, and claims 26 and 27 were newly added.

Accordingly, claims 1-27 remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15

3. Claims 1-2, 5-8, 10-13, 17, and 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Tracy et al. (US 5,979,757).

Re claims 1-2, 5-8, 10-13, 17, and 19-27: Tracy et al. discloses a system/method a handheld recommendation assistant 70 comprising reading, by a barcode scanner 75 or a RFID tag reader (col. 3, lines 3-1-38), the product information of a product from a product tag (i.e., a UPC code/barcode tag or a RFID tag); retrieving consumer information through a connection (i.e., a connection network/LAN) (col. 9, lines 6-55) to a consumer information storage device (i.e., a database of a remote server or a local database stored on customer's identification card, which can be a smart card (or a floppy disk (col. 13, lines 34+)); acquiring personal information
25 of a user relevant to at least one aspect of the product through an interface on the handheld

Art Unit: 2876

device (i.e., a touch sensitive display, which serves as an interface for inputting personal information (e.g., password, etc.)), generating a product recommendation related to the product based on at least in part on the personal information and the consumer information (col. 9, lines 55+ and 60+), wherein generating a product recommendation comprising comparing the personal
5 information and the consumer information to produce a comparison result, identifying at least one recommended product whose consumer information is consistent with the personal information, and recommending the at least one recommended product via the display 72 (i.e., price, product name, quantity, recipes, nutritional information and promotion, etc.), wherein the product recommendation is determined by a remote server, which is a central host (col. 14, lines
10 15+ and lines 60+ and col. 15, lines 34+). See figs. 1-4 and 7A-E; col. 3, lines 30+; col. 4, lines 1-42; col. 5, lines 36+; col. 6, lines 39+ and lines 57+; col. 7, line 34 through col. 11, line 28; and col. 13, lines 34+.

Claim Rejections - 35 USC § 103

15 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
25 claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 2876

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3-4, 9, and, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

5 Tracy et al. in view of Suzuki (US 6,129,274). The teachings of Tracy et al. have been discussed above.

Re claims 3-4, 9, and 13-16: Tracy et al. has been discussed above but fails to teach or fairly suggest that the personal information including tailoring measurements, a color preference. Suzuki teaches the above limitation with the personal information including tailoring

10 measurements, a color preference (col. 4, lines 20+ and col. 10, lines 55+).

In view of Suzuki's disclosure, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of into Suzuki the teachings of Tracy et al. in order to provide the user/customer is provided with a complete recommendation of products that is fit to his/her needs (i.e., his/her desired size and color), and
15 thus providing a more user friendly system. Furthermore, such modification would have been an obvious extension as taught by Tracy et al., and therefore an obvious expedient.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. The teachings of Tracy et al. have been discussed above.

Re claim 18, Tracy et al. has been discussed above but fails to teach or fairly suggest the
20 step of storing the product information in a machine readable form in the product tag; and attaching the product tag containing the machine readable product information to the product.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the step of storing the product information in a machine readable form in the product tag and attached the product tag to the product in order to provide Tracy et al. with a faster system wherein the product information can be retrieved readily one the product tag is read by the handheld device, and thus providing a time consuming system. Furthermore, such modification would have been an obvious extension as taught by Tracy et al., and therefore an obvious expedient.

Response to Arguments

8. Applicant's amendment and arguments filed on May 9, 2003 have been fully considered, but they are not persuasive.

Applicant amended independent claim 1 such that the claim now reads "A method for a handheld recommendation assistant generating a product recommendation related to said product based at least in part on aid personal information and said consumer information, the product recommendation being generated by the handheld recommendation assistant. In doing so, Applicant contends that the claimed invention is distinct from Tracy or Tracy in view of Suzuki (See remarks section, page 8, 2nd paragraph thereafter).

However, it is the Examiner opinion that the Tracy patent still teaches the subject matter claimed in the amended claims. The shopping assistant of Tracy clearly suggest

"recommendation" functionality (col. 9, lines 55+), wherein the customer can be alerted based on selected criteria (i.e., cholesterol, calories, fat contents, etc.) of a product.

Although Applicant's explanations distinguishing the claimed invention from Tracy/Suzuki that "specifies that the handheld recommendation assistant itself makes a recommendation to the user, rather than a central host" (page 9, 1st paragraph), it is the Examiner's position that the Tracy patent teaches that the device makes the recommendation
5 itself. In terms of where the database resides in making recommendations, Tracy may not explicitly suggest that the database is loaded in the hand-held terminal. Examiner also notes, upon careful reading of claim 1, that the claim 1 of instant application does not explicitly suggest such feature – database is resident on the handheld device as opposed to a central host.

Wirth respect to the subject matter disclosed in newly added claims 26 and 27, the
10 product assistant of Tracy also features "link" function (col.10, lines 9+), which retrieves information from various manufactures. Such navigation (or information retrieval) can be achieved when a merchant, consumer, and manufacturers are connected by appropriate network infrastructure such as LAN, WAN, and Internet connections.

The amended claims and remarks describing these elements have been given careful
15 consideration, however, in view of the above, Tracy/Suzki still teach the claimed invention of instant application. Therefore, the Examiner has made this Office Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time
20 policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 2876

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

5 however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shepley (US 5,478,989) discloses customer information terminal in retail environment.

10 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

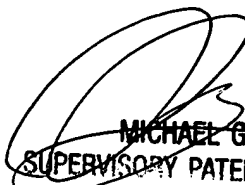
25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

30 

Ahshik Kim
Patent Examiner
Art Unit 2876

35 August 11, 2003


MICHAEL G. LEE
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